

REMARKS

The above-referenced patent application has been reviewed in light of the Office Action referenced above. Reconsideration of the above-referenced patent application in view of the following remarks is respectfully requested.

Claims 1-19 are pending in the application. Claims 1, 4, 13, 14, 16, and 17 have been amended. Claims 20-28 have been added. The amendment is fully supported by the original disclosure. No new matter has been introduced. The above amendment were, in many instances, made to clarify Assignee's claims and do not narrow the scope of the amended claims. Furthermore, in many instances, the above amendments broaden the literal scope of claims and/or claim elements.

Claim rejections - 35 USC §102

Claims 1, 6, 9-14 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Collins (U.S. Patent No. 4,025,068). These rejections are respectfully traversed.

Assignee respectfully submits that Collins does not disclose all of the elements of independent claim 1. The Examiner is kindly reminded that the Examiner's initial burden of factually supporting any conclusion of anticipation includes that:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. (See MPEP § 2131.01.)

For example, Examiner has not established that Collins discloses "*an elastic member, wherein the elastic member is capable of causing the idle roller to exert a force on the belt to maintain tightness in the belt during feeding of the document; and wherein the idle roller and belt are located so as to receive the document via a feed-in path and to transmit the document via a feed-out path, and wherein the idle roller and belt are located so as to receive the document*

between the idle roller and the belt", as recited in claim 1. In the Office Action the Examiner has asserted that:

Collins discloses ... **an idle roller (12); an elastic member (20)**, wherein the elastic member is capable of causing the idle roller to exert a force on the belt to maintain tightness in the belt during feeding of the documents (as the roller penetrates into the belt the belt is tightened; col. 3, lines 30 et seq.). (See page 2 of the Office Action, emphasis added.)

Assignee cannot agree. Specifically, the Examiner has provided no support from Collins that there is any device (such as the **spring 20** of Collins) that is an *"elastic member capable of causing the idle roller to exert a force on the belt to maintain tightness in the belt"*, as recited in claim 1. Conversely, in column 3, lines 28-68 of Collins, an **"adjustable means"** of Collins is described as follows:

In order to compensate for different characteristics of substrates to be fed by separator 11, such as, different thicknesses, weights, bonds and stocks, **retard member 12 has an adjustable means** (not shown since any convention means is appropriate) for adjusting the gap adjacent the retard member and the feed member 10 when the operative setting zone of the retard member is adjacent the feed member to **set predetermined penetration of the retard member** relative to the feed member. While it was disclosed that the retard member is adjustable relative to the feed member, it should be understood that the separator member 11 could be moved relative to a stationary retard member if one desired. The advantage of this adjustment for different sheet characteristics over prior art devices is the minor adjustment needed. In the apparatus of the present invention the flat on the retard roller is set for standard sheet characteristics, and any adjustment for sheet differences is from that standard.

By setting the retard wheel assembly 10 flush to the feed belt 11 at the flat position on the wheel, and then indexing the wheel to a sector of the usable retard surface, **proper depth of penetration of the retard wheel into the deformable belt is fixed**. This method of setting the correct penetration of the retard roller into the feed belt has advantages over present devices in that this simple adjustment of penetration depth makes tolerance requirements on both the feed belt and retard pad less stringent. Ease of adjustment of this apparatus to accomplish separation of different types of substrates fed therethrough are obtained by allowing with the use of conventional means (not shown); the retard wheel assembly to move in only one plane, for instance, with that plane being perpendicular to the belt which makes for squareness of the flat surface of the retard wheel to the belt surface. This adjustability allows quick and easy fine tuning at a user's location. A particular user who runs card stock on onion skin paper can peak the feeder

performance by adding or subtracting from standard penetration for his particular need. (See column 3, lines 28-68 of Collins, emphasis added.)

Accordingly, Assignee first submits that the Examiner has not established that the **adjustable means** of Collins anticipates an *"elastic member capable of causing the idle roller to exert a force on the belt to maintain tightness in the belt"*, as the Examiner has not established that the **adjustable means** of Collins performs any function other than to **fix** a "proper depth of penetration of the retard wheel into the deformable belt". See column 3, lines 51-52 of Collins. Second, Assignee submits that the Examiner has not established that it is the **spring 20** of Collins, and **not** the **adjustable means** of Collins, that is an *"elastic member capable of causing the idle roller to exert a force on the belt to maintain tightness in the belt"*, as recited in claim

1. Conversely, in column 4, lines 1-22 of Collins, "spring 20" of Collins is described as follows:

As can be seen from FIG. 1, a simple and easy method of replacing belt 11 as well as retard roller 12 is disclosed by the use of the flat 17 on retard wheel 12. The retard wheel is manually indexed around ratchet wheel 18 against the bias of pawl 19 and spring 20 that is supported within stationary bar 21. The ratchet wheel is rotated until the flat surface or sector of retard wheel 12 is immediately adjacent belt 11. The belt is effortlessly removed and replaced with a new belt and by simply continuing to index retard roller 11 to a new sector on the surface thereof, the correct penetration depth for proper sheet separation is assured. In order to allow for adjustments for different thicknesses of paper to be separated by roller 12 as they travel between roller 12 and belt 11, the retard roller is adjustable in a vertical plane as viewed in FIG. 1. In order to allow for the adjustment of retard roller 12 in this vertical plane, there is shown in FIG. 1 screw 22 that allows **spring 20** as well as pawl 19 to be adjustable within fixed support 21 by turning screw 22 in order for pawl 21 to continue to be seated within ratchet wheel 18 once vertical adjustment is made with the retard roller. (See column 4, lines 1-22 of Collins, emphasis added.)

Assignee submits that the Examiner has not established that the **spring 20** of Collins anticipates an *"elastic member capable of causing the idle roller to exert a force on the belt to maintain tightness in the belt"* as the Examiner has not established that the **spring 20** of Collins performs any function other than to seat the pawl 21 of Collins "within ratchet wheel 18 **once vertical**

adjustment is made with the retard roller". See column 4, lines 20-22 of Collins. In the absence of the Examiner pointing to such a disclosure in Collins, Assignee requests that the rejection be withdrawn as the Examiner has failed to establish that Collins discloses the identical invention as is required for anticipation. See MPEP § 2131.

Likewise, claims 6, 9-14 and 16, as well as new claims 20-28 distinguish from Collins on at least the same or similar basis as claim 1. Therefore, Assignee respectfully requests that Examiner's rejection of claims 1 6, 9-14 and 16 be withdrawn.

Claim rejections - 35 USC §103

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Collins (U.S. Patent No. 4,025,068) in view of Ota (Japanese Patent No. 63092542). Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Collins in view of Tuchiya et al. (U.S. Patent No. 4,085,929). Claims 15 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Collins in view of Tanno et al. (U.S. Patent No. 6,309,064). These rejections are respectfully traversed.

In response, Assignee respectfully submits that claims 2, 3, 4, 5, 15 and 17-19 are not obvious, at least on the same or similar basis as claim 1 as set forth above with respect to the anticipation rejection in view Collins. The Examiner is kindly reminded that the Examiner's initial burden of factually supporting any *prima facie* conclusion of obviousness includes that:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (See MPEP § 2143.03.)

Specifically, the Examiner has failed to establish that Collins teaches or suggests "*an elastic member, wherein the elastic member is capable of causing the idle roller to exert a force on the belt to maintain tightness in the belt during feeding of the document; and wherein the idle*

roller and belt are located so as to receive the document via a feed-in path and to transmit the document via a feed-out path, and wherein the idle roller and belt are located so as to receive the document between the idle roller and the belt", as recited in independent claim 1. Additionally, the Examiner has not established that Ota and/or Tuchiya and/or Tanno cure Collins of this failure. In the absence of the Examiner pointing to such a suggestion, Assignee requests that the rejection be withdrawn as the Examiner has failed to establish that the proposed combinations render claims 2, 3, 4, 5, 15 and 17-19 are obvious.

Likewise, new claims 20-28 distinguish from the proposed combinations on at least the same or similar basis as claim 1.

It is noted that claimed subject matter may be patentably distinguished from the cited reference for additional reasons; however, the foregoing is believed to be sufficient. Likewise, it is noted that the Assignee's failure to comment directly upon any of the positions asserted by the Examiner in the office action does not indicate agreement or acquiescence with those asserted positions.

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Conclusion

In light of the foregoing, reconsideration and allowance of the claims is hereby earnestly requested.

Invitation for a Telephone Interview

The Examiner is invited to call the undersigned attorney, James J. Lynch, at (503) 439-6500 if there remains any issue with allowance.

Additional fees

Any fees or extensions of time believed to be due in connection with this amendment are enclosed herein; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-3703.

Respectfully submitted,
Attorney for Assignee

Dated: November 15, 2006

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